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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,095	08/17/2000	Donald B. Benson	40016420-0001	5295
26565	7590	03/08/2005	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 190 SOUTH LASALLE ST CHICAGO, IL 60603-3441			WOO, RICHARD SUKYOON	
			ART UNIT	PAPER NUMBER

3629

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/641,095

Applicant(s)

BENSON, DONALD B.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004 and 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9, 13-15, 18, 21-23 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 9, 13-15, 18, 21, 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07-06-2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Examiner's Remark

- 1) The indicated allowability of claims 9, 13-15, 18, 21 and 28 is withdrawn in view of the newly discovered reference(s) to Humes et al. and Delfer, III (infra). Rejections based on the newly cited reference(s) follow.
- 2) The Applicant's amendments filed June 14, 2004 and November 5, 2004 have been entered.

### *Claim Rejections - 35 USC § 103*

- 3) Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. (US 5,287,976).

W.R.T. Claim 9, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and

a sortation device (60); and

a print head (18) printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications (see Fig. 1).

However, Mayer et al. does not expressly disclose the second print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et

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al. for the purpose of printing the identifier information on the publication faster and more efficiently.

W.R.T. Claim 28, Mayer et al. discloses a system comprising:

a plurality of pockets for receiving the plurality of publications (see Fig. 5);

a merge stream for merging the plurality publications; and

a print head (18) printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications (see Fig. 1).

However, Mayer et al. does not expressly disclose the second print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the

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publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

4) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. and in view of Delfer, III (US 5,264,665)

W.R.T. Claim 13, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and  
a sortation device (60).

However, Mayer et al. does not expressly show the system including a thickness measurement device and scale.

Delfer, III teaches utilizing the thickness measurement device and scale (30 in Fig. 1A) for optimizing the mailing discount rates.

It would have been obvious to a person having ordinary skill in the art at the time of invention to employ the scale and thickness gage by the system, as taught by Delfer, III, for the purpose of optimizing the postal discount for the mailing.

5) Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Humes et al. (US 5,377,120).

W.R.T. Claims 14-15, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and

a sortation device (60).

However, Mayer et al. does not expressly show the system including a co-mailer merge and sequence module for receiving a plurality of verified sequence list from the bindery, each of the plurality of verified sequence lists containing the order for each of the plurality of publications received from the bindery, the co-mailer merge and sequence module merging each of the plurality of verified sequence lists to create a merged verified sequence list, the merged verified sequence list sequenced in the order to determine the mail rate.

Humes et al. teaches an apparatus for co-mailing mail pieces by taking the various mailing lists, merging and sorting the entries into lowest postal rate groupings and utilizing this merged data base to enable a sequence controller and associated device to physically co-mail and address the mail pieces (see Figs. 1-3 and the descriptions thereof; abstract; and col. 2, lines 38-68).

It would have been obvious to a person having ordinary skill in the art at the time of invention to incorporate the co-mailer merge and sequence module of Humes et al. into the co-mailing system of Mayer et al., for the purpose of preparing a plurality of preprinted un-addressed, non-alike mail pieces from un-predetermined sources into grouped bundles organized in a manner to receive low postal rates.



6) Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Delfer, III and Humes et al..

W.R.T. Claim 21, Mayer et al. discloses a method comprising:

providing an order to a bindery, the order defining an order that each of a plurality of publications are bound by the bindery;

binding a plurality of signatures to create the plurality of publications, each of the publications being in the order, the binding further including:

selecting the plurality of signatures based on at least one field in the record list for each of the plurality of recipients;

binding the plurality of signatures selected in the selected step;

printing the identifier information from the sequence list on the plurality of signatures;

merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'); and

sorting the plurality of publications by the mail rate; and

sending the plurality of publications to the recipients.

However, Mayer et al. does not expressly show the method including measuring a thickness and weight of each of the plurality of publications.

Delfer, III teaches utilizing the thickness measurement device and scale (30 in Fig. 1A) for optimizing the mailing discount rates.

It would have been obvious to a person having ordinary skill in the art at the time of invention to measure the weight and thickness of each of the plurality of publications and insert the measurement into the sequence list, as taught by Delfer, III, for the purpose of optimizing the postal discount for the mailing.

The modified method of Mayer et al. discloses the invention as recited above, but does not expressly include:

- providing the order in a form of a record list to a bindery sequence list module in communication with the bindery, the record list containing an identifier information for each of the plurality of recipients; and

- sequencing the record list in a predetermined sequence to obtain a sequence list used to determine a mail rate; and

- verifying the order of the each of the plurality of publications, updating the sequence list to record each of the plurality of publications.

Humes et al. teaches an apparatus for co-mailing mail pieces by taking the various mailing lists, merging and sorting the entries into lowest postal rate groupings and utilizing this merged data base to enable a sequence controller and associated

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device to physically co-mail and address the mail pieces (see Figs. 1-3 and the descriptions thereof; abstract; and col. 2, lines 38-68).

It would have been further obvious to a person having ordinary skill in the art at the time of invention to incorporate the co-mailer merge and sequence module of Humes et al. into the co-mailing system of Mayer et al. so as to provide the order in a form of a record list to a bindery sequence list module in communication with the bindery; sequence the record list in a predetermined sequence; and verify the order of the each of the plurality of publications, update the sequence list to record each of the plurality of publications, for the purpose of preparing a plurality of preprinted un-addressed, non-alike mail pieces from un-predetermined sources into grouped bundles organized in a manner to receive low postal rates.

#### ***Allowable Subject Matter***

7) Claims 22-23 are allowed.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

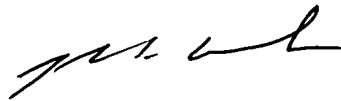
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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March 07, 2005



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